

## REMARKS

Applicants respectfully request reconsideration of this application, and reconsideration of the Office Action of November 18, 2004. Upon entry of this Amendment, claims 5, 9, 12, 34, 35, 37, 38, 40, 42-49, 51, and 52 will remain pending in this application. New claims 53 and 54 are added. The changes to the claims and the newly added claims are supported by the specification and original claims. No new matter is incorporated by this Amendment. Moreover, no additional claim fees are believed due as a result of this Amendment.

Applicants gratefully acknowledge the Examiner's indication that claims 5, 9, 12, 34, 35, 37, and 42 are allowed.

\* \* \* \* \*

Claim 33 was objected to as being a substantial duplicate of claim 9. However, claim 33 has been canceled thereby rendering this rejection moot.

Claim 44 also was objected to for depending from a rejected claim. However, the claims from which claim 44 depend have been amended in a manner that addresses the previous rejections (see below). Hence, claim 44 is believed to be in condition for allowance and withdrawal of the objection is requested.

\* \* \*

Claims 38, 40, 43, 45-49, 51, and 52 were rejected under 35 U.S.C. §112, second paragraph, as indefinite.

Applicants first address the rejection as it applied to claims 40, 43, 45-48, 51, and 52. Claims 40, 43, 45, 47 have been amended to indicate the claims are to be interpreted as reciting closed language with respect to the DNA fragment.

Applicants now turn to the rejection of claims 38, 43, 51, and 52. Again, the claims have been amended to indicate they are to be interpreted as reciting closed language with respect to the DNA fragment. However, Applicants note, for example, the vector of claim 43 can include components other than the fragment.

With respect to claim 49, the claim has been amended so that it no longer depends from claim 35 and to refer to the claims from which it depends in the alternative. Applicants also added new claim 53 which corresponds to claim 39 depending from claim 35, but reciting closed language with respect to the DNA fragment.

Hence, in view of the above, Applicants submit the rejection has been overcome and its withdrawal is respectfully requested. Moreover, should the Examiner believe the claims are not in condition for allowance, Applicants respectfully request the Examiner contact Applicants' undersigned representative to discuss alternative language.

\* \* \*

Claim 49 was rejected under 35 U.S.C. §112, first paragraph, as purportedly containing new matter. As an initial matter Applicants note claims 30, 31, 33, and 36 have been canceled by this Amendment. Moreover, the Office Action indicates that claim 49 as it depends from claims 5, 34, 35, and 37 complies with 35 U.S.C. §112. However, with respect to claim 49 as it depends from claim 9, Applicants respectfully traverse this rejection.

Claim 9 has been indicated as being allowed. Moreover, the specification teaches how to transform a bacterium, such as *E. coli*, with a polynucleotide. See pages 8-9. Hence, Applicants submit that when the specification is taken as a whole, those of ordinary skill in the art would readily recognize that claim 49, as it depends from claim 9, is adequately described in the specification as originally filed and thus does not constitute new matter. Accordingly, withdrawal of this rejection is requested.

\* \* \*

Claims 30, 31, 36, 38 and 49 were rejected under 35 U.S.C. §112, first paragraph, for not being fully enabled by the specification. Applicants again point out that claims 30, 31, and 36 are canceled. Hence, claims 38 and 49 no longer depend from claims 30, 31, or 36 and fully comply with 35 U.S.C. §112. Applicants submit this rejection is overcome and respectfully request it be withdrawn.

\* \* \* \* \*

Applicants respectfully submit that this Amendment and the above remarks obviate the outstanding objections and rejections in this case, thereby placing the application in condition for allowance. Allowance of this application is earnestly solicited.

If any fees under 37 C.F.R. §§1.16 or 1.17 are due in connection with this filing, please charge the fees to Deposit Account No. 02-4300; Order No. 032301.230.

If an extension of time under 37 C.F.R. §1.136 is necessary that is not accounted for in the papers filed herewith, such an extension is requested. The extension fee should be charged to Deposit Account No. 02-4300; Order No. 032301.230.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By:

*fr*

*Robert G. Weilacher* Feb. 15/05  
Robert G. Weilacher, Reg. No. 20,531  
1850 M Street, N.W., Suite 800  
Washington, D.C. 20036  
Telephone: (202) 263-4300  
Facsimile: (202) 263-4329

Dated: February 15, 2005